

Remarks

Claims 1-5, 8-9, 12-14, 16-18, 21-23, 25-27, 29-32, 34-44, 46, 48-50, 52-61, 63, and 65-68 are currently pending. Claims 1-5, 8-9, 12-14, 16-18, 21-23, 25-27, 29-32, 34-44, 46, 48-50, 52-61, 63, and 65-68 stand rejected. Claims 1, 9, 25, 27, 38, 40, 53, and 67 have been amended. Applicant asserts that the claims are now in condition for allowance as set forth more fully below.

102 Rejections

Claims 1-5, 8, 13-14, 16-18, 21, and 67-68 stand rejected under 35 USC 102(e) as being unpatentable over Baker (US Pat 6,517,167). Applicant respectfully traverses these rejections to the extent they apply to the current set of pending claims.

Examiner alleges that Baker ‘167 teaches each element of the above-listed claims. Baker ‘167 teaches a wheel with a first decorative member 13 which has areas of material removed to provide a suitable shape, configuration or ornamentation and a second decorative member 16 which is positioned outside the first decorative member 13 relative to wheel 11 which both members are attached to. Baker ‘167 at column 3, lines 16-31.

Applicant respectfully submits that not every element of Applicant’s claims is taught in Baker ‘167. Applicant’s claim 1 includes recitations wherein (1) a visual element (adjacent a first rotating member) has an outer perimeter, and (2) a second member (mounted to rotate adjacent the first rotating member) which defines an opening having an outer perimeter. Claim 1 further recites that the first rotating member and second member are adapted to be moved between a first position in which said outer perimeter of said opening does not align with said outer perimeter of said visual element; and a “home position wherein said **outer perimeter of said opening is aligned with said outer perimeter of said visual element.**” Applicant submits that Baker ‘167 fails to teach at least two recitations of pending claim 1, (1) the shapes of the outer perimeters of Baker’s first decorative member and second decorative member are different and thus never “align”, and (2) according to the teachings of Baker ‘167 the two outer perimeters never in fact align.

As illustrated below in Figure 1, Applicant has highlighted the outer perimeter of Baker '167's first decorative member 13. In Figure 2, Applicant has reproduced Baker '167's second decorative member 16 and Applicant has highlighted the "opening" in Baker '167's second decorative member 16 with a dashed line.

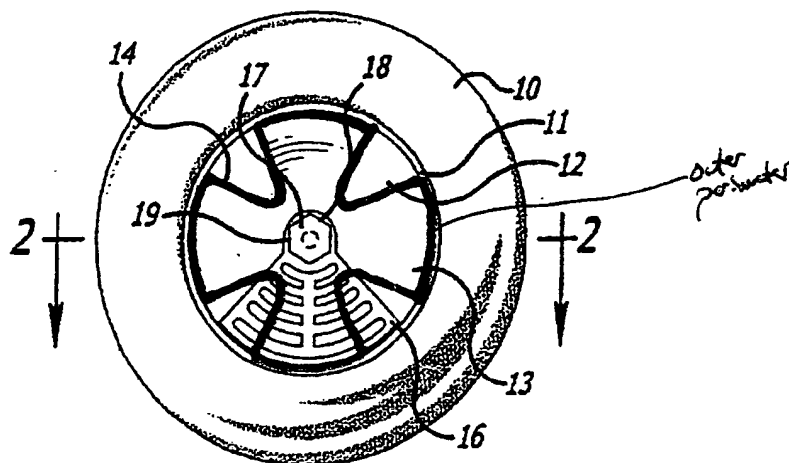


Figure 1 FIG. 1 from Baker '167 Showing Outer Perimeter of Element 13

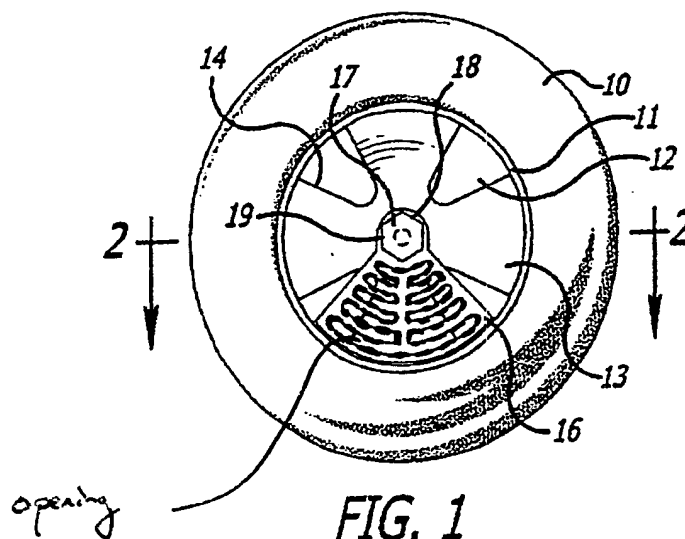


Figure 2 FIG. 1 from Baker '167 Showing Outer Perimeter of the Opening of Element 16

The shapes of the respective perimeters of Baker's decorative members 13, 16 are completely different and would never be "aligned" as in Applicant's pending claim 1.

With regard to item (2), Applicant suggests that Examiner has misinterpreted the rotation of Baker's second decorative member relative to the first decorative member to be the same as the "first position" and "home position" of pending claim 1, but this is simply not the case. In Baker, the second position rotates relative to the first member, but due to the completely different perimeters, there is never a time at which the perimeters of the two members are aligned, instantaneously or otherwise.

Accordingly, Baker '167 fails to disclose all of the elements of claim 1, and claim 1 is allowable over Baker '167 for at least these reasons. Dependent claims 2-5, 8, 13-14, 16-18, and 21 depend from an allowable claim 1 and are also allowable for at least the same reasons.

Applicant submits that claim 16 is also additionally allowable over Baker '167 because Baker '167 does not teach the recitations of claim 16. To wit, Applicant's claim 16 further comprises "an aligning mechanism for maintaining said second member in said home position relative to said first rotating member." As discussed above, Applicant submits that Baker '167 fails to teach the "home position" in which the outer perimeter of the first decorative member is aligned with the outer perimeter of the opening of the second member. Further, even if Baker were to teach such a position, there is no mechanism taught in Baker '167 for maintaining this position (as discussed in detail in Applicant's specification). As Examiner notes throughout the Office Action, Baker '167's second member rotates with respect to the first member and thus, does not maintain a position with respect to the first member as described in Applicant's specification. Thus, Applicant submits that pending claim 16 is allowable over Baker '167 for at least this additional reason.

Applicant also submits that claim 17 is allowable over Baker '167 both for its dependence on independent claim 1, but also for its dependence on claim 16 as discussed above. In addition, Applicant submits that the recitations of pending claim 17 are not taught in Baker '167. To wit, claim 17 recites an aligning mechanism which facilitates movement of the second member to the home position relative to the first member. As discussed above, there is no teaching in Baker '167 of the "home position" but Applicant further notes that there is no teaching of such a mechanism as in claim 17 in which the mechanism facilitates a movement to this "home position." While Baker '167 may teach

a second member which is weighted to maintain a position relative to the ground, Baker '167 does not teach a mechanism for facilitating movement to a home position in that the home position is defined by the positioning of two members, the first decorative member and the second member, and not merely a single member by itself relative to the ground. As Baker '167 fails to teach aligning the two members to each other, Baker '167 fails to teach the elements of pending claim 17 for this additional reason.

Examiner has also rejected independent claim 67 over Baker '167. Applicant submits that each and every element of pending claim 67 is not taught by Baker '167. Claim 67 recites “an aligning mechanism for selectively orienting said second member in a home position relative to said first rotating member.” As discussed above and incorporated herein, Baker '167 only teaches a second element which is weighted and does not teach an “aligning mechanism” which orients the second member to a home position relative to the first member. At most, Baker '167 teaches a second member which orients to a position relative to the ground and Baker does not teach any mechanism of the second member orienting the members relative to each other as in the pending claim.

Accordingly, Baker '167 fails to disclose all of the elements of claim 67, and claim 67 is allowable over Baker '167 for at least these reasons. Dependent claim 68 depends from an allowable claim 67 and is also allowable for at least the same reasons.

103 Rejections

Claims 9, 22-23, 25-27, 31-32, 34-40, 43-44, 46 and 48-50 stand rejected under 35 USC 103(a) as being unpatentable over Baker in view of Wang '810 (US Pat 6,799,810). Examiner alleges that Baker contains all of the limitations of the claims but does not show a plurality of openings in the second member corresponding to multiple visual elements.

With respect to claims 9 and 22-23, Applicant herein incorporates the remarks above with regard to claim 1 from which these claims depend. Applicant submits that these claims are allowable due to their dependency on an allowable base claim and that Wang '810 does not cure the deficiencies of Baker '167.

In addition, Applicant submits that there would be no motivation for one of ordinary skill in the art to combine the teachings of Baker '167 and Wang '810 as there is no teaching, suggestion or motivation to do so. Applicant notes that the mechanisms behind each of Baker '167 and Wang '810 are entirely different. In Baker '167 an inner member is fixed to a wheel such that it rotates when the wheel rotates and an outer member is attached to the wheel, but it does not rotate with the wheel although it too may rotate. In Wang '810, on the other hand, the inner member is able to rotate relative to the wheel whereas the outer member is fixed in relation to the wheel. Thus someone practicing the invention or teachings of Baker '167 would not look to Wang '810 and vice versa. Further, there is no teaching or suggestion in either of these arts that would incline someone to consider the other as they are simply two different ways of creating and using wheel covers.

Further, Applicant submits that dependent claim 9 is allowable for at least the additional reason that it includes a recitation that is not taught in Baker '167. Claim 9 recites a second visual element (from claim 8) and a second opening wherein the outer perimeter of the first opening aligns with the outer perimeter of the first visual element and the outer perimeter of the second opening aligns with the outer perimeter of the second visual element. As discussed above, Baker '167 fails to teach a first visual element outer perimeter that aligns with an outer perimeter of an opening in a second visual element. Wang '810 similarly fails to teach such an alignment. Wang '810 teaches a rotating element but it does not teach such an alignment. Figure 3 below is a reproduction of Wang '810's FIG. 4 and clearly illustrates the alignment of Wang's two members.

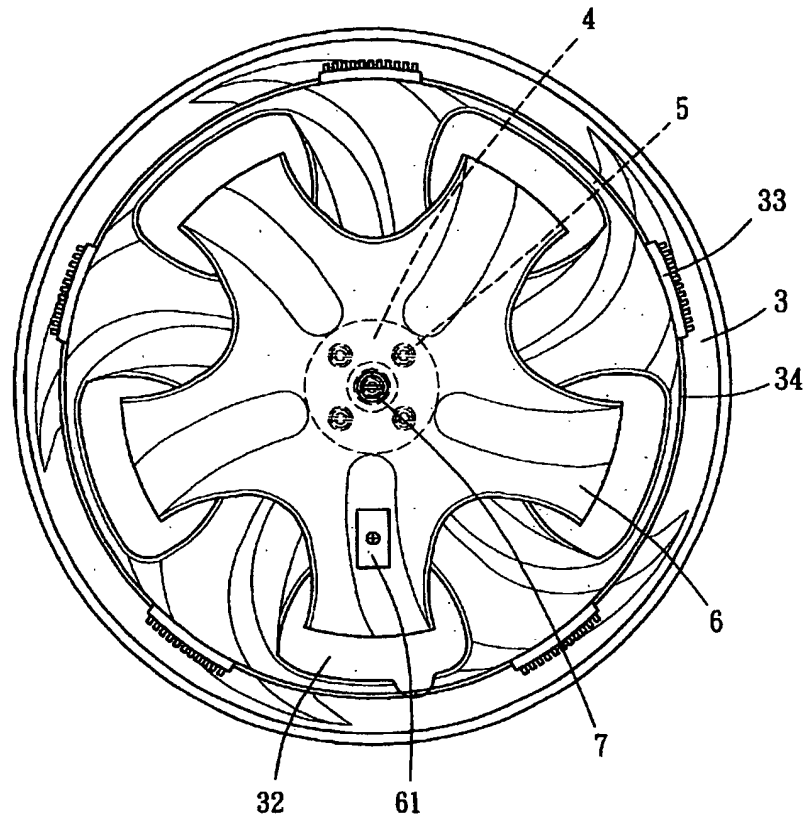


FIG. 4

Figure 3 Wang '810's FIG. 4

As seen by Wang '810's inner decorative member 6 and windows 32, there is never an alignment of a perimeter of window 32 and a perimeter of inner decorative member 6. Further, claim 9 is currently amended to clarify that the first outer perimeter of the first opening and the first outer perimeter of the first visual element are a same shape. Applicant submits that neither Baker '167 nor Wang '810 teach the perimeters having the same shape as in the currently amended claim. For at least these additional reasons Applicant submits that claim 9 is allowable over the cited prior art.

With regard to independent claim 25, Applicant submits that the combination of Baker '167 and Wang '810 fails to teach each and every element of pending claim 25. Applicant herein incorporates the remarks made above with regard to claim 1. In particular, Applicant notes that Baker '167's fails to teach a wheel assembly wherein two members are adapted to move between a first position in which a perimeter of an opening

in a rotating member is aligned with a perimeter of a themed element as recited in pending claim 25.

Accordingly, Baker '167 fails to disclose all of the elements of claim 25, and claim 25 is allowable over Baker '167 for at least these reasons. Dependent claims 26-27, 31-32 and 34-37 depend from an allowable claim 25 and are also allowable for at least the same reasons.

Further, and as discussed above with regard to claim 9 and which remarks are incorporated herein, neither Baker '167 nor Wang '810 teach a themed wheel assembly in which respective outer perimeters of openings are in alignment with respective outer perimeters of visual elements as in pending claims 26, 27 and 29. For at least these additional reasons, claims 26, 27 and 29 are allowable over the cited prior art either singly or in combination.

Claim 34 is further allowable over the cited prior art as it further comprises an aligning mechanism affixed to the rotating member for maintaining the rotating member in the home position relative to the wheel. As discussed above, and incorporated herein, neither Baker '167 nor Wang '810 disclose such a mechanism. For at least this additional reason, claim 34 is allowable over the cited prior art either singly or in combination.

Independent claim 38 is also allowable over the cited prior art as the prior art does not teach each and every element of claim 38. In part, claim 38 recites “a plurality of openings configured to substantially mirror the pattern of said plurality of visual elements of said wheel; and wherein said wheel and said wheel spinner are adapted to be rotated between: a first position in which said plurality of openings do not align with said plurality of visual elements, and a home position in which said plurality of openings are aligned with said plurality of visual elements.” (Emphasis added)

As discussed above, and incorporated herein, neither Baker '167 nor Wang '810 teach such recitations and claim 38 is allowable over the cited prior art for at least these reasons. Dependent claims 39, 40, 43, 44, 46 and 48-50 depend from an allowable claim 38 and are also allowable for at least the same reasons.

Further, with regard to claim 40, Applicant again states that the cited prior art fails to disclose an assembly in which a home position is obtained wherein there is alignment

between the perimeters of openings and visual elements. Accordingly, claim 40 is allowable over the cited prior art for at least this additional reason.

As related to claim 46, the cited prior art fail to disclose an aligning mechanism which maintains the wheel spinner in the home position. Accordingly, claim 46 is allowable over the cited prior art for at least this additional reason.

Claim 12 stands rejected under 35 USC 103(a) as being unpatentable Baker '167 in view of Hoxie (US Pat D384,021). Examiner alleges that Baker '167 contains all of the limitations of the claims but does not show the visual element being themed indicia.

With respect to claim 12, Applicant herein incorporates the remarks above with regard to claim 1 from which this claim depends. Applicant submits that this claim is allowable due to its dependency on an allowable base claim and that Hoxie '021 does not cure the deficiencies of Baker '167. In addition, Applicant respectfully submits that there is no teaching, motivation or suggestion in either prior art that would incline one of ordinary skill in the art to combine the teachings of these prior arts. In particular, Applicant notes that Baker '167 teaches a complex wheel spinner in which there are bearings to permit one member to move relative to another member. There is no teaching, suggestion or motivation to one of ordinary skill of complex wheel spinners consulting with a design patent for a novelty wheel cover in which there are no moving parts and for which there is no rotation of the wheel cover relative to the wheel. Thus, Applicant respectfully submits that these prior arts are not properly combined in this rejection and that the rejection should therefore be removed and claim 12 is allowable over the cited prior art.

Claims 29-30, 41-42, 53-61, 63 and 65 stand rejected as being unpatentable over Baker '167 in view of Wang '810 further in view of Hoxie '021.

With respect to claims 29-30, Applicant herein incorporates the remarks above with regard to claim 25 from which these claims depend. Applicant submits that these claims are allowable due to their dependency on an allowable base claim and that Hoxie '021 does not cure the deficiencies of Baker '167 and Wang '810. In addition, and as

stated above with regard to claim 12 which remarks are hereby incorporated herein, Applicant suggests that one of ordinary skill in the art of complex wheel spinners would not consult the teachings of Hoxie '021 and that the rejection is therefore improper. For at least these reasons, claims 29-30 are allowable over the cited prior art.

With respect to claims 41-42, Applicant herein incorporates the remarks above with regard to claim 38 from which these claims depend. Applicant submits that these claims are allowable due to their dependency on an allowable base claim and that Hoxie '021 does not cure the deficiencies of Baker '167 and Wang '810. In addition, and as stated above with regard to claim 12 which remarks are hereby incorporated herein, Applicant suggests that one of ordinary skill in the art of complex wheel spinners would not consult the teachings of Hoxie '021 and that the rejection is therefore improper. For at least these reasons, claims 41-42 are allowable over the cited prior art.

With respect to independent claim 53, Applicant submits that the cited prior art fails to teach each and every element of the pending claim and that claim 53 is therefore allowable. In particular, and as stated above with regard to claim 1 (among others), which remarks are hereby incorporated herein, Applicant submits that none of the cited prior art, either singly or in combination, teaches an assembly with a home position in which the outer perimeter of the opening is aligned with bullet indicia (aka first decorative member), thereby resembling a loaded revolver-cylinder as in pending claim 53.

In addition, and as stated above with regard to claim 12 which remarks are hereby incorporated herein, Applicant suggests that one of ordinary skill in the art of complex wheel spinners would not consult the teachings of Hoxie '021 and that the rejection is therefore improper.

Accordingly, neither Baker '167, Wang '810 nor Hoxie '021 disclose all of the elements of claim 53, and claim 53 is allowable over the cited prior art for at least these reasons. Dependent claims 54-61, 63 and 65 depend from an allowable claim 53 and are also allowable for at least the same reasons.

Applicant further submits that claim 63 is also additionally allowable over the cited prior art because the cited prior art does not teach the recitations of claim 63. To

wit, Applicant's claim 63 further comprises "an aligning mechanism for orienting said second member in said home position relative to said wheel." As discussed above, Applicant submits that the cited prior art fails to teach the "home position" in which the outer perimeter of the first decorative member is aligned with the outer perimeter of the opening of the second decorative member. Further, even if Baker '167, Wang '810 or Hoxie '021 were to teach such a position, there is no mechanism taught in them for orienting the second decorative member into this position. Thus, Applicant submits that pending claim 63 is allowable over the cited prior art for at least this additional reason.

Claim 52 stands rejected as being unpatentable over Baker '167 in view of Wang '287 (US Pat D495,287 S). Examiner alleges that Baker '167 contains all of the elements of claim 52, but does not show the wheel spinner (aka second member) having a substantially circular body with circular openings. Examiner alleges that Wang '287 teaches such an element.

Applicant respectfully disagrees with Examiner's allegation and that furthermore, there is no teaching, suggestion or motivation to combine Wang '287 with Baker '167. Wang '287 is for a disk wheel cover and is not in the area of complex wheel spinners of Baker '167. Furthermore, Applicant must respectfully disagree with Examiner's contention that Wang '287 teaches a plurality of substantially circular openings uniformly distributed about the median area of the element. At best, Wang '287 teaches a hubcap with a plurality of oblong substantially rectangular openings and not substantially circular elements as in claim 52. However, in order to clarify the claim, the claim has been amended such that the openings are circular. As noted above, neither of the cited prior arts shows circular openings and, thus, not each and every element of previously presented claim 52 is taught and the claim is therefore allowable.

Claim 66 stands rejected under 35 USC 103(a) as being unpatentable over Baker in view of Wang '810 and further in view of Hoxie and further in view of Wang '287. Examiner alleges that Baker as modified by Wang '810 and Hoxie does not show the outer periphery of the spinner (aka second member) including substantially

semi-circular recesses about its circumference. Examiner alleges that Wang '287 teaches such an element.

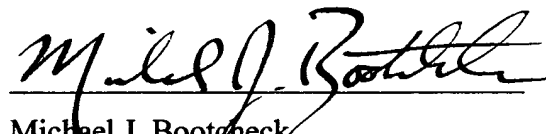
Pending claim 66 depends from independent claim 53 and the remarks above regarding claim 53 are hereby incorporated by reference. Further, Applicant is unable to find any teaching, suggestion or motivation in Baker '167 that would suggest to one of ordinary skill in the art of complex wheel spinners to consult with design patent fixed wheel covers such as Wang '287 and Hoxie '021. Absent such teaching, suggestion or motivation, the rejection is improper and Applicant respectfully requests that the rejection be removed as improper and the claim found allowable.

Conclusion

Applicant asserts that the application including Claims 1-5, 8-9, 12-14, 16-18, 21-23, 25-27, 29-32, 34-44, 46, 48-50, 52-61, 63, and 65-68 is in condition for allowance. Applicant requests that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due.

Respectfully submitted,



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